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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,194	01/22/2004	Chang-Chin Lai	LAIC3028/EM	2335
23364	7590	02/16/2006	EXAMINER	
BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314			PATEL, FAHD	
			ART UNIT	PAPER NUMBER
			2194	

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/761,194	Applicant(s) LAI, CHANG-CHIN	
	Examiner Fahd Patel	Art Unit 2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-6 are pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no discussion of *how* the claimed invention is to be implemented by the described method. The specification must include technical information specifically relating to how the linking and copying of the shortcut is to occur.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Shmueli et al. (hereafter Shmueli).

6. As per claim 1 Shmueli teaches:

installing an application in a memory device in advance (10, Fig. 1; p. 2, par. 0029);

connecting the memory device to an electronic device prior to use (p. 3, par. 0034);

automatically copying the application as a linked shortcut in an OS of the electronic device (p. 5, par. 0047, 0049);

showing an icon of the shortcut on a screen of the electronic device (86, Fig. 5);
and

clicking the icon for opening the application, thereby enabling the electronic device to run the application (p. 5, par. 0049-0050).

7. As per claim 2, Shmueli teaches that the memory device is a portable disk having a USB connector so that the memory device is adapted to connect to the electronic device having a USB port by inserting the USB connector into the USB port (Fig. 2A).

8. As per claim 3, Shmueli teaches that the electronic device is a notebook computer having at least one USB port so that the memory device may connect to the electronic device (p. 2, par. 0027-0028).

9. As per claim 5, Shmueli teaches that the electronic device is a PDA (p. 2, par. 0028).

10. As per claim 6, Shmueli teaches that the memory device is a memory card (Fig. 2B; p. 8, par. 0098).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shmueli, and further in view of Yang et al. (U.S PG Pub 2003/0110371 A1), hereafter Yang.

13. As per claim 4, Shmueli teaches that responsive to connecting the memory device to the electronic device, the application automatically copies itself as a linked shortcut in the OS of the electronic device, the icon of the shortcut is shown on the screen of the electronic device, and the electronic device is enabled to run the

application (see rejection to claim 1 above). Shmueli does not specifically teach an autorun feature.

14. Yang teaches that the application has an embedded autorun (p. 2, par. 0015).


15. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the autorun feature from Yang with Shmueli's invention. Both inventions deal with interaction between an electronic device and a memory device. The ability to automatically run the program from a memory device adds to the convenience and ease of use of the invention, which is a valuable motivation (Yang, p. 1, par. 0005; Shmueli, p. 1, par. 0004).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Arner et al. (U.S PG Pub 2001/0047393).
- Harrison et al. (U.S PG Pub 2003/0208573).
- Tarau et al., A Logic Programming Infrastructure for Remote Execution, Mobile Code and Agents, Enabling Technologies: Infrastructure for Collaborative Enterprises, 1997, pages 106-111.
- Theimer et al., Preemptable remote execution facilities for the V-system, ACM Symposium on Operating Systems Principles, Pages: 2 – 12, Year of Publication: 1985.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fahd Patel whose telephone number is (571) 272-1044. The examiner can normally be reached on 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Thompson can be reached on (571) 272-3718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. 

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FHP


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